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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,040	02/05/2002	Christopher Feistel	FEIST-001BG	9735

7590

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EXAMINER

NGUYEN, BAO THUY L

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/068,040

Applicant(s)

FEISTEL, CHRISTOPHER

Examiner

Bao-Thuy L. Nguyen

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1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

2. Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged. However, the parent application (09/418,864) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for the claims of this application. The instant claims are adequately supported by application number 09/668,966 filed on 25 September 2000.

### *Election/Restrictions*

3. Applicant's election of claims 11-17 in the reply filed on 03 March 2005 is acknowledged. Claims 1-10 have been canceled.

*Drawings*

4. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 13 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 13 recites a device having a lateral flow mesh formed to have a generally perpendicular orientation relative to the vertical flow mesh. Such a device is not supported by the specification as originally filed. Nowhere in the specification is there a discussion of this specific feature.

Claim 17 recites a device where the magnet is disposed beneath the flow meshes, i.e. between the lateral flow mesh and the backing. Such a device is not supported by the specification as originally filed. The specification teaches that the magnet is disposed beneath the backing and not on the backing.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 11-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 lacks a correlation between the preamble and the descriptive limitations of the device. Nothing in the description relates to the magnetic property of the "magnetic test strip".

The description of the lateral flow mesh and the vertical flow mesh are also confusing. It is unclear how these meshes have been constructed such that they can be considered "lateral" or "vertical".

Claims 13 and 14 are confusing with respect to the recitation that the lateral flow mesh is formed to have a generally perpendicular or diagonal orientation relative to said vertical flow mesh. Generally speaking, a material define as a mesh is "a net or network or a fabric having an open network of interlacing threads" (Webster's Dictionary), therefore, a mesh, in itself, would

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have fibers running parallel and perpendicular to each other to form a network of pores. Thus, it is confusing how the instant "lateral" and "vertical" flow meshes are defined.

Claim 13 also appear to lack antecedent support in the specification as originally filed.

Claim 16 is confusing because it is unclear how the magnet is disposed. Is it adhered to the backing? In other words, is it a permanent part of the test strip?

### *Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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10. Claims 11-15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Thayer et al (US 6,528,323 B1).

Thayer discloses a test strip comprising a membrane strip positioned over a backing strip and serves as a diffusion passageway for the membrane strip. The test strip comprising two absorbent pads positioned at opposite ends. A sample pad is positioned over the membrane strip. The entire construction is placed in a housing leaving a sample well for addition of the sample. See column 12, line 30 through column 13, line 50. Figures 2 and 5.

Even though Thayer does not specifically use the terms “vertical flow mesh” and “lateral flow mesh” to describe the sample addition pad and the membrane strip, these two elements are functionally equivalent to the meshes of the instant invention because they are made of the same material (nylon, column 13, line 18), and the sample addition pad clearly facilitates a vertical flow to the membrane strip underneath. The membrane strip is clearly recited as providing lateral flow. As discussed above, a mesh is general described as a net or network having appropriate pore openings, since the membrane and sample pad of Thayer are made of the same material as the meshes of the instant invention, they would be expected to having the same inherent properties.

*Allowable Subject Matter*

11. Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
12. Claims 16 and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
13. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or make obvious a test strip having a magnet disposed underneath a support backing in the location where a test sample would be added.

*Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

EP 0,447,154 A2  
US 4,952,520  
US 5,082,626  
US 5,104,619  
US 5,296,192  
US 5,712,170  
US 5,965,375  
US 6,326,214

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao-Thuy L. Nguyen whose telephone

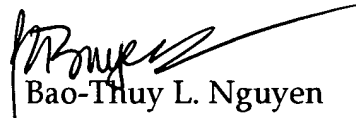


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number is (571) 272-0824. The examiner can normally be reached on Tuesday and Thursday from 8:00 a.m. -3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Bao-Thuy L. Nguyen  
Primary Examiner  
Art Unit 1641  
4/29/05